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Remarks

Claims 1-47 are presented for the Examiner's consideration. Claims 1-15, 46 and 47 are withdrawn from consideration by the Examiner and claims 16-45 have been examined.

First, the Examiner requires a restriction requirement, dividing claims 16-45 (Group II) from claims 1-15, 46 and 47 (Group I). In a telephone conversation with the Examiner, Applicants provisionally elected, **with traverse**, Group II, claims 16-45 to be examined in this application. Applicants reaffirm this election and this reaffirmance is made **with traverse**. Applicants specifically reserve the right to seek patent protection for non-elected subject matter in a divisional application.

Applicants respectfully submit that the Examiner's restriction requirement is in error because the inventions of Group I and Group II are not related as intermediate-final product and are so closely related that a full and proper consideration of the invention of Group II must include a search for the material of Group I, claims 1-15.

In order for an intermediate and final product relationship to be present, typically, the intermediate must lose its identity in the final product (MPEP 806.04(b)). As set forth in MPEP 806.04(f), in order for species to be mutually exclusive the general test is that one claim recites limitations which are related to the first species but not the second, while a second claim recites limitation disclosed only for the second species and not in the first. This is clearly not the case here. All of the limitation of the first species (the protective material) are present in the second species (storage sleeve). Hence, there is not a mutually exclusive relationship present. This is not an admission that if a reference teaching all of the limitations of Group I anticipates Group II or renders Group II obvious. However, a reference which anticipates Group II would also anticipate Group I, provided that all of the same claim limitations defining the storage sleeve of Group II are present in the Group I claims. Further, claims 46 and 47 are not directed a sensitive protective material, but to a process of protecting a sensitive surface and a stack of articles having a sensitive surfaces of each article separated by the protective material, respectively.

Therefore, the Examiner's basis for making the restriction requirement is improper, since Group I and Group II are not mutually exclusive species in an intermediate final product relationship, for the reasons set forth above. Applicants hereby request that the Examiner examine claims 1-47 together.

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Claim 16 was objected to as being dependent on a non-elected claim. Claim 16 has been amended to include all of the limitations of claim 1 and is now an independent claim. Therefore this claim objection is rendered moot in view of the forgoing amendments.

Claim 17 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is respectfully traversed. In the statement of the rejection, the Examiner states that claim 17 is indefinite for reciting the physical properties of the nonwoven. Ex parte Slob, 157 U.S.P.Q. 172 (Bd. of Appl. (1968)).

The Examiner's reliance on Ex parte Slob is misplaced. The Examiner finds Slob to support the proposition that any claim reciting physical features of an article is indefinite. In Slob, the claims were found to be indefinite on the basis that there were many possible liquefiable materials which could not be used in the powder detergent composition of Slob. The language was found to be indefinite since it covers everything which performs the desired function and claims the composition by the desired function.

In clear contrast, the Applicants have discovered that a nonwoven web having the balance of physical properties of density, stiffness and the presence of voids is very effective in protecting surfaces. The claims of the present application define the parameters which the nonwoven must meet, in order for the claim to be infringed and for the nonwoven to be effective. It is this balance of properties which is the Applicants' invention. The mere presence of physical properties in a claim do not render a claim indefinite, unless the physical properties encompass subject matter which is not usable in the invention, and/or claims a feature by desired function.

Claims 16-20 were rejected under 35 U.S.C. § 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over McDevitt et al. US 2003/0050589. This rejection is respectfully traversed.

First, it is pointed out that McDevitt et al. is assigned to the Assignee of the present application and the present application and McDevitt et al. were under duty of assignment to the present Assignee at the time the inventions were made. Therefore McDevitt et al. is not available as a reference under 35 U.S.C. § 103 since the present application was filed after November 29, 2000, in accordance with 35 U.S.C. § 103(c).

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With respect to the rejection under 35 U.S.C. § 102(e), Applicants point out that McDevitt et al. is directed to a disposable finger sleeve, used to treat ailments of appendages. There is no disclosure of using the product of McDevitt as a storage sleeve. Applicants point out that in order for a claim to be anticipated, all the limitations of the claims must be taught by the reference. Here, since the claims are to a storage sleeve, which has meaning to those skilled in the art, and this feature is not taught by McDevitt et al., McDevitt et al. does not anticipate the Applicants' claims.

Claims 16-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Drew U.S. Patent 6,186,320 in view of McDevitt et al. US 2003/0050589. This rejection is respectfully traversed.

As stated above, McDevitt et al. is not available as a reference against the present application since it is currently assigned to the Assignee of the present application and was under obligation of assignment to the Assignee of the time the invention was made. Therefore, the foregoing rejection is untenable and should be withdraw.

In view of the foregoing amendments and remarks, it is respectfully submitted that the present application is in condition for allowance. Such allowance is respectfully requested.

The undersigned can be reached at 770-587-7204.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE

I, Rosemarie Enright, hereby certify that on September 5, 2003 this document is being transmitted via facsimile (703-872-9310) addressed to Examiner Lynda Salvatore, Art Unit 1771.

By: Rosemarie Enright
Rosemarie Enright

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